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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,736	05/31/2000	Avner Shafrir	52817.0001i2	2786

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,736

Applicant(s)

SHAFRIR ET AL.

Examiner

Tadesse Hailu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the AMENDMENT entered on December 6, 2004 for the patent application number 09/583,736.
2. The present patent application claims priority from domestic US Application 60/137,513 filed April 2, 1999.
3. The pending claims 1-38 are examined as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis LTD. Quick Tour. February 12 1998 in view of ICO Inc, 1CQ Email Signature, May 2 1999.

ICQ, as disclosed in Mirabilis LTD, Quick Tour, is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence (on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line

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(status indicator) as well. Thus status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Furthermore, as described below, it is clear that the current claims are not distinguishable over the cited art.

With regard to claim 1:

Claim 1 recites, among other things, "communication selection means," ICQ, as described in Quick Tour, describes that users can launch any one of the communication modes selected from a user's menu, such as chat (in real time), e-mail, etc. The status indicator reflects the selected mode of communication (Quick Tour, pages 6-7).

As per "communication means," ICQ, as described in Quick Tour, allows you to contact other 1CQ users on the Internet by clicking the name (identifier) or the icon next to it and then send a message, initiate a chat session (real-time) or launch any other interactive session (communication mode) (Quick Tour, pages 6-7);

As per "user indicator presentation means," ICQ, as described in Quick Tour, teaches user indicators, such as user's name, ICQ's unique ID number, etc that are associated with the user. As mentioned above when one of the indicators are selected, it allows you to establish a communication with other users (Quick Tour, pages 6-7). However, ICQ, as described and illustrated in Quick Tour, fails to teach "presenting one or more user indicators within the two or more types of electronic documents, wherein the electronic documents types are capable of being generated using two or more types of applications"

ICQ, in ICQ Email Signature, describes this shortcoming. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., HTML user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

With regard to claims 8, 15, 22, and 30-33:

The remaining independent claims, 8, 15, 22, 30-33 are rejected for the same reason given to claim 1. Claims 30 and 32 further call for a status indication module associated with a first system application and a communication selection module associated with a second system application, wherein, the first and second system applications are different system applications. ICQ, as describes in Quick Tour, also teaches the above limitations, wherein status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (Quick Tour, pages 5-6). Furthermore, ICQ does provide plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on

the Internet (see page 2), wherein user's status can be associated with different applications.

With regard to claims 2, 10, 16, and 24:

As per claims 2, 10, 16, and 24, the ICQ user can control his/her availability to other users by choosing one of the many options; such as if the user does not want to be disturbed he clicks "Do not Disturb" option (Quick Tour, page 5). All other users receive this information as well and have a clear idea on the status.

With regard to claims 3, 11, 17, and 25:

As per claims 3, 11, 17, and 25, the ICQ further teaches that urgent communication request can be sent from other users and this overrides the previous "Do not Disturb" status will be replaced by "Occupied (Urgent Msgs) (Quick Tour, page 5).

With regard to claims 4-7, 12-14, 18-21, and 26-29:

As per claims 4-7, 12-14, 18-21, 26-29, as mentioned above, the ICQ does provide several communication mode to a user. Such communication mode includes, among others, e-mail, chat, send message files and URLs, play games, draw on whiteboards, and communicating through voice while surfing the net (Quick Tour, pages 6-7). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, pages 6-7).

With regard to claims 9 and 23:

As per claims 9 and 23, as described above, ICQ also describes selecting a user indicator to establish or launch a desired mode of communication with the selected user (Quick Tour, pages 6-7).

With regard to claims 34 and 36:

Furthermore, ICQ (Quick Tour & Email Signature) discloses the status indication of the plurality of communication modes comprises a plurality of status indicators that correspond to the plurality of communication modes (Quick Tour, pages 4-8). ICQ further describes the user has full control over the way his availability (communication mode) is presented to other users. ICQ users can notify other users what communication mode they are using or available, and the status indicator corresponds to the selected communication mode (Quick Tour, pages 4-8).

With regard to claims 35 and 37:

Furthermore, ICQ (Quick Tour & Email Signature) discloses activating at least one communication mode includes selecting at least one of the pluralities of status indicators to initiate activation (Quick Tour, pages 4-8). ICQ further describes selecting a recipient from contact list and communicating with the selected recipient based on the recipient availability (communication mode) selected (selected status) (Quick Tour, pages 4-8).

With regard to claim 38:

In addition to the limitations claimed in the above independent claims, the instant claim recites documents generated by the two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web

document, etc, see Quick Tour), the claim further recites each document includes at least two user depictions associated with at least two network users (which is similar to Quick Tour in view of Email Signature users indicator icons, see Quick Tour, pages 4-8); claim 38 also recites an identification determining module that references the user directory to access at least two user indicators (which is similar to Quick Tour in view of Email Signature name, ICQ number or contact list , see Quick Tour, pages 4-8).

Response to Arguments

5. Applicants' arguments filed December 6, 2004 have been fully considered but they are not persuasive. The applicants argues that "Quick Tour and ICQ Email Signature, both alone and in combination fail to teach or suggest communication selection means for providing a status indication of a plurality of communication modes associated with the one or more user indicators and enabling selection of at least one communication mode from the plurality of communication modes based on the status indication." The Examine disagrees because Quick Tour in view of ICQ Email Signature discloses the above claimed features. When ICQ user communicates with another ICQ user or recipient, that is, by selecting the recipient from the contact list, the recipient availability (communication mode) will be shown. That is recipient can setup their preferred availabilities (status indications) (see Quick Tour, 4-8). For example one may be available for random chat (Quick Tour, page 5).

Applicant submit a copy of a portion of the homepage of the Wayback Machine website. Applicant further states that the archive data is only represented by the Wayback Machine as being accurate for the homepage, and not for other archived

pages linked thereto. The Examiner disagrees because each complete URL pages has its own corresponding posting date. For example, one of the references cited ("How to Use ICQ") has a complete URL name

<http://web.archive.org/web/19980212181102/www.icq.com/icqtour/fulltour.html>, wherein the posting date is 2/12/98. Similarly, the ICQ Email Signature has its own complete URL name, that is,

<http://www.archive.org/web/19990502092623/9cq.com/emailsig.html>, wherein the posting date is 5/2/1999. While the Applicant does not argue the publishing date of "How to Use ICQ", but the Applicant argues for the ICQ Email Signature publication date. The examiner would like to indicate the Applicant by entering any one of the above URL, one can only reach to a designated particular page not to a home page as applicant suggested. Therefore, the publication date relied upon by the Examiner for ICQ Email Signature is correct.

Conclusion

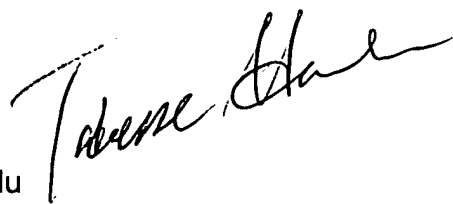
6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

7. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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A handwritten signature in black ink, appearing to read "Tadesse Hailu". The signature is written in a cursive, flowing style with a large initial "T".

Tadesse Hailu
12/21/2004